



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: )  
KLOSTERMAN, WADE C. )  
Serial No.: 09/613,514 )  
Filed: 07/10/2000 )  
Title: )  
VOICE FEEDBACK TIMER SYSTEM )

Docket No.: 27553  
Group Art Unit No.: 2841  
Examiner: Miska, Vit W

#12/47  
re Appeal  
Brief  
WZ  
7/18/03

Mail Stop Appeal Brief - Patents  
Commissioner For Patents  
Post Office Box 1450  
Alexandria, Virginia 22313-1450

TECHNOLOGY CENTER 2800

JUL 15 2003


RECEIVED

REQUEST FOR REINSTATEMENT OF APPEAL

In response to the Office Action dated April 9, 2003, which followed the Applicant's original Brief on Appeal and which reopened prosecution, reinstatement of the Applicant's appeal is respectfully requested as provided for under 37 CFR §1.193(b)(2)(ii). As required, a supplemental Brief on Appeal is filed herewith.

Any fee due in connection with this request or with the supplemental appeal brief should be applied against Deposit Account No. 19-0522.

Respectfully submitted,

By 

Thomas B. Luebbering, Reg. No. 37,874  
HOVEY WILLIAMS LLP  
2405 Grand Boulevard, Suite 400  
Kansas City MO 64108  
(816) 474-9050  
ATTORNEY FOR APPLICANT



07-10-03

AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of )

KLOSTERMAN, WADE C. )

Serial No. 09/613,514 )

Filed: 07/10/2000 )

Title: VOICE FEEDBACK TIMER SYSTEM )

Group Art Unit 2859

Examiner: Vit W. Miska

Mail Stop Appeal Brief - Patents  
Commissioner For Patents  
Post Office Box 1450  
Alexandria, Virginia 22313-1450

EXPRESS MAIL TRANSMITTAL

Transmitted herewith are: Express Mail Transmittal (1 pg); Request for Reinstatement of Appeal (1 pg); Supplemental Appeal Brief (48 pgs) in Triplicate; and Return Postcard.

EV343764026US

("Express Mail" Mailing Label Number)

Respectfully submitted,

HOVEY WILLIAMS LLP

Date: July 9, 2003

By

Thomas B. Luebbering, Reg. No. 37,874  
2405 Grand Boulevard, Suite 400  
Kansas City, Missouri 64108  
(816) 474-9050  
Fax (816) 474-9057

ATTORNEYS FOR APPLICANT

(Docket No. 27553)

RECEIVED  
JUL 15 2003  
TECHNOLOGY CENTER 200



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: )  
KLOSTERMAN, WADE C. )  
Serial No.: 09/613,514 )  
Filed: 07/10/2000 )  
Title: )  
VOICE FEEDBACK TIMER SYSTEM )

Docket No.: 27553  
Group Art Unit No.: 2841  
Examiner: Miska, Vit W

#13/Supp.  
Appeal/  
Brief  
KF  
7/18/03

TECHNOLOGY CENTER 2800

JUL 15 2003

RECEIVED

---

## SUPPLEMENTAL APPEAL BRIEF

---

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	)	
KLOSTERMAN, WADE C.	)	
	)	
Serial No.: 09/613,514	)	Docket No.: 27553
	)	
Filed: 07/10/2000	)	Group Art Unit No.: 2841
	)	
Title:	)	Examiner: Miska, Vit W.
VOICE FEEDBACK TIMER SYSTEM	)	

---

Mailstop Appeal Brief - Patents  
Commissioner For Patents  
Post Office Box 1450  
Alexandria, Virginia 22313-1450

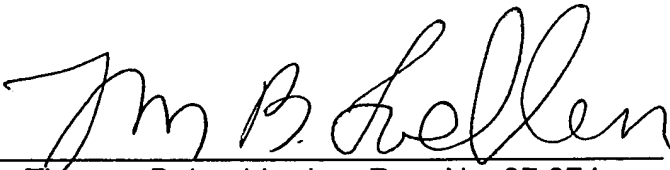
RECEIVED  
JUL 15 2003  
TECHNOLOGY CENTER 2800

APPLICANT'S SUPPLEMENTAL BRIEF ON APPEAL

In response to the Office Action dated April 9, 2003, which followed the Applicant's original Brief on Appeal and which reopened prosecution, reinstatement of the Applicant's appeal is respectfully requested and the Applicant's Supplemental Brief on Appeal in accordance with 37 C.F.R. §1.192 is hereby submitted in triplicate. The original Brief on Appeal is hereby incorporated by reference. The Examiner's rejections of claims 1-11 and 15-18 as last amended are herein appealed, and allowance of said claims is respectfully requested.

Any fee due in connection with this supplemental brief with this amendment should be applied against Deposit Account No. 19-0522.

Respectfully submitted,

By 

Thomas B. Luebbering, Reg. No. 37,874  
HOVEY WILLIAMS LLP  
2405 Grand Boulevard, Suite 400  
Kansas City MO 64108  
(816) 474-9050

ATTORNEY FOR APPLICANT

Following are the requisite statements under 37 C.F.R. §1.192:

**I. Real Parties in Interest**

Wade C. Klosterman is the sole inventor of the claimed invention. Assignment by Wade C. Klosterman was executed on July 7, 2000, to WC Man Productions, the real party in interest.

**II. Related Appeals and Interferences**

No related appeals or interferences are known to the Appellants which may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. Status of Claims**

The application, as originally filed, contained eleven (11) claims, with claims 1 and 6 being the only independent claims.

A first Office Action was mailed on October 26, 2001, rejecting claims 1-5 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,854,774 (hereinafter referred to as "Timme") in view of U.S. Patent No. 4,379,640 ("Inoue"), and rejecting claims 6-11 under 35 U.S.C. §103(a) as being unpatentable over Timme and Inoue in further view of U.S. Patent No. 5,444,673 ("Mathurin"). In response, arguments were made that the cited references themselves provided no relevant motivation or suggestion to combine their teachings, and that the motivations asserted by the Examiner would both fail to result in the claimed invention and render the references unsuitable for their intended purposes.

Additionally, seven (7) new claims, claims 12-18, were added, with claims 12, 15, and 18 being independent.

A second Office Action was mailed on July 16, 2002, rejecting claim 12 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,690,566 ("Robertson"); repeating the aforementioned rejections of claims 1-5 under 35 U.S.C. §103(a) over Timme in light of Inoue and of claims 6-11 under 35 U.S.C. §103(a) over Timme and Inoue and in further view of Mathurin; rejecting claims 13-14 under 35 U.S.C. §103(a) over Robertson; rejecting claims 15-17 under 35 U.S.C. §103(a) over Robertson in view of Inoue; and rejecting claim 18 under 35 U.S.C. §103(a) over Robertson in view of Inoue and Mathurin. These rejections were made final. In response, a Notice of Appeal was filed.

A Brief on Appeal was filed on January 21, 2003, appealing the rejections of claims 1-11 and 15-18 while withdrawing claims 12, 13, and 14 from consideration on appeal.

In response, a third Office Action was mailed on April 9, 2003, almost three months after the Applicant's Brief was filed, wherein the Examiner re-opened prosecution by yet again rejecting all pending claims, claims 1-18. More specifically, the Examiner rejected claims 1, 3, 6, 8, and 11 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,794,205 ("Walters"); rejected claims 12 and 15 under 35 U.S.C. §102(b) as being anticipated by Robertson; rejected claims 2 and 7 under 35 U.S.C. §103(a) as being unpatentable over Walters in view of U.S. Patent No. 4,629,329 ("Komiyama"); rejected claims 4, 5, 9, and 10 under 35 U.S.C. §103(a) as being unpatentable over Walters in view of U.S. Patent No. 5,442,600 ("Kutosky"); rejected claims 13, 14, 16, and 17 under 35 U.S.C. §103(a) as being unpatentable over Robertson; and rejected claim 18 under 35 U.S.C. §103(a) over Robertson in view of Walters and Komiyama. As a result, the

Applicant is forced to file the present Supplemental Brief on Appeal, though it is the Applicant's assertion that no new and necessary grounds for rejection have been set forth justifying reopening prosecution. As the Examiner has not expressly withdrawn the previous grounds for rejection (i.e., over Timme, Inoue, Mathurin, and Robertson), the Applicant's responses thereto set forth in the Applicant's original Brief on Appeal are hereby incorporated by reference into the present supplemental Brief on Appeal.

Claims 1-18 are currently pending. Claims 12, 13, and 14, however, are withdrawn from consideration on appeal. Thus, the rejections of claims 1-11 and 15-18 are appealed.

#### **IV. Status of Amendments**

All amendments submitted by the Appellant have been entered.

#### **V. Summary of the Invention**

It is often desirable to measure the passing of a time period in order to limit the duration of an activity. Commonly, this involves using an alarm clock or wristwatch to measure the passing of time and to indicate the expiration of a predefined period of time. Relatively sophisticated apparatuses exist, such as the aforementioned alarm clock and wristwatch, which are able to measure periods of time with reference to an actual time of the day. Though varying in complexity, cost, and available functions, these apparatuses typically include a timekeeping function comprising a clock and an associated display whereby the actual time of the day is displayed; a timer and an associated alarm; mechanisms whereby the clock and alarm may be set; and a "snooze" or delay function.

Because these apparatuses inseparably combine the roles of general timekeeping and fixed-period timing, users requiring only a timing function are forced to purchase, carry, program, and use the inseparable timekeeping function as well. Thus, rather than merely setting a timer, a user must convert the length of the desired timed period into an actual time of the day and then set the alarm with reference to that actual time. For example, if, at 11:52am, a user wishes to time a fifteen minute period, he or she would have to calculate that the corresponding ending time would be 12:07pm, and would then have to enter this time by setting the hour, the minute, and the am/pm indicator. Depending on the mechanism provided for entering the desired time, the user might have to wait as each digit or value advances from some default or previously set starting value to the desired value. Once the alarm is set relative to actual time, additional steps may be required to activate the alarm such that it will sound when the set time is reached. Because of the inefficiency of associating simple fixed period timing with actual time, such apparatuses are much too inefficient, complex, and expensive for users requiring a simple timer.

Another disadvantage of conventional timers and alarm clocks, particularly for those with vision-related disabilities, is the lack of any non-visual feedback from the apparatus indicating, for example, that the alarm has been set or cleared, or which of different types of alarms will sound when the set time has been reached. Also, conventional timers and alarm clocks are typically limited to alarms consisting of either nonsense tones or radio programming with no capability for customization.

The present invention provides a timing device (10) adapted to measure discrete intervals of time without reference to an actual time of day, and to allow for substantial flexibility with regard to the nature of the alarm communicated at the expiration of the timed

period. In a preferred embodiment, the device (10) broadly comprises a timer (12); a minute button (14); an hour button (16); a controller (18); a voice chip (20); a record button (22); a microphone (24); a memory element (26); a speaker (28); an earphone jack (30); a snooze button (32); and a housing (34). Pages 3-4.

The timer (12) is operable to measure the length of the desired period of time without reference to the actual time of day. Page 4. The minute and hour buttons (14,16) allow for setting the length of the timed period, and the snooze button (32) allows for extending the length of the timed period following its initial expiration. Page 4. The minute button (14) is associated with fifteen minute periods and may be depressed up to three times, each of which adds an additional fifteen minutes to the timed period, for a maximum of forty-five minutes. Page 4. Similarly, the hour button (16) is associated with one-hour periods and may be depressed up to four times, each of which adds one hour to the length of the timed period, for a maximum of four hours. Page 4. Five seconds after either the minute or hour buttons (14,16) are activated the controller (18) will cause the timer (12) to run, thereby avoiding any problem of setting but forgetting to activate the alarm. Page 4. If, however, the minute button (14) is pressed a fourth time, or the hour button (16) is pressed a fifth time, then the timer (12) will clear and no timing will occur, or, if already started, will stop and clear. Page 4. Thus, the device (10) advantageously allows both the alarm to be set and the timing function initiated by depressing a single button representing a discrete unit of time (e.g., one hour, fifteen minutes). In an alternative embodiment, the device (10) includes a scan button which, when depressed, operates to cause the device (10) to audibly advance or scan through a number of choices or settings. Page 7.

At the end of the timed period, the controller (18) initiates the sounding of the alarm and controls playback of feedback announcements when appropriate. Page 5. The voice chip (20) allows the device (10) to produce human speech for replaying recorded messages and for providing feedback announcements regarding the setting or clearing of the timed period or other operation of the device (10). Page 5. The record button (22), microphone (24), and memory element (26) cooperate to allow for recording a message for future playback. Page 5. The alarm, whether chimes or message playback, and the feedback announcements may be communicated through the speaker (28). Page 6. Where such generally audible communication is not desired, earphones may be electrically connected to the earphone jack (30) to bypass the speaker and allow for listening without disturbing others or informing others of the contents of the recorded messages. Page 6.

Thus, using the present invention rather than the prior art alarm clock or wristwatch described above, the user, at 11:52am, wishing to time a fifteen minute period, need merely depress the minute button (14) once. Advantageously, it is not necessary to calculate or set the corresponding time (i.e., 12:07pm) or to depress any other buttons or take any other action. As mentioned, the timing begins automatically five seconds later, thereby advantageously avoiding any problem of setting but forgetting to activate the alarm. Furthermore, by eliminating timekeeping in favor of more general timing, and by limiting the length of the timed period to discrete multiples of a predetermined number of minutes or hours, the present invention allows for a less complex, less expensive, and lighter timing device which is much easier and faster to use than prior art alarm clocks or wristwatches. Users who frequently nap for discrete blocks of time, truckdrivers and students for example, will appreciate that the alarm may be set and the timing initiated with

as little effort as the push of a single button. Travelers will appreciate the device's light weight and lack of dependence on local time.

Another advantage of the present invention, particularly for those with vision-related disabilities, is its ability to provide the aforementioned audible feedback announcements indicating the operation or operative mode of the device, including that the alarm has been set or cleared and which of the different alarm types will sound at the end of the timed period. These audible feedback announcements are also advantageous for users who do not wish or are unable to direct their attention to a display for information concerning operation of the device (10).

Another advantage of the present invention is its ability to record the aforementioned short messages to be played at the end of the timed period in lieu of a default alarm tone. This allows a user to remind him- or herself or another of an important event or action to take upon expiration of the timed period. Thus, for example, the person setting the alarm can leave an instructional message for another person who will be present when the alarm sounds.

## **VI. Issues**

- A. Whether, with regard to the rejections of claims 1, 3, 6, 8, 11, and 15 under 35 U.S.C. §102, the cited prior art references disclose each, every, and all claimed elements identically as claimed.

1. *Whether, with regard to the rejections of claims 1, 3, 6, 8, and 11 under 35 U.S.C. §102(b) over Walters, Walters discloses each, every, and all claimed elements identically as claimed.*
  2. *Whether, with regard to the rejection of claim 15 under 35 U.S.C. §102(b) over Robertson, Robertson discloses each, every, and all claimed elements identically as claimed.*
- B. Whether, with regard to the rejections of claims 2, 4, 5, 7, 9, 10, and 16-18 under 35 U.S.C. §103, the requisite *prima facie* case of obviousness has been established.
1. *Whether, with regard to the rejections of claims 2 and 7 under 35 U.S.C. §103(a) over Walters in view of Komiyama, a reasonable motivation or suggestion has been identified for the proposed modification of Walters.*
  2. *Whether, with regard to the rejections of claims 4, 5, 9, and 10 under 35 U.S.C. §103 over Walters in view of Kutosky, the combination teaches or suggests all of the claim limitations.*

3. *Whether, with regard to the rejections of claims 16 and 17 under 35 U.S.C. §103 over Robertson, a reasonable motivation or suggestion for the proposed modification has been identified.*

4 *Whether, with regard to the rejection of claim 18 under 35 U.S.C. §103 over Robertson in view of Walters and Komiyama, a reasonable motivation or suggestion for the proposed modification has been identified.*

C. Whether the Examiner has, with regard to the rejections of claims 2, 4, 5, 7, 9, 10, 13, 14, and 16-18 under 35 U.S.C. §103(a), considered the invention as a whole.

D. Whether reopening prosecution was proper.

## **VII. Grouping of Claims**

In accordance with 37 C.F.R. §1.192(c)(7), it shall be noted that the claims stand and fall together.

## **VIII. Arguments and Authorities**

- A. With regard to the rejections of claims 1, 3, 6, 8, 11, and 15 under 35 U.S.C. §102, the cited prior art references do not disclose each, every, and all claimed elements identically as claimed.**

35 U.S.C. §102(b) states in relevant part that “[a] person shall be entitled to a patent unless the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States...” For rejections based on anticipation, there is no question of obviousness or modification of the reference, rather a single reference must teach each, every, and all aspects of the claimed invention either explicitly or impliedly, and any feature not directly taught must be inherently present. *Verdegaal Bros. v. Union Oil Co. Of California*, 2 USPQ2d 1051,1053 (Fed. Cir. 1987); MPEP §§706.02 and 2131. “The identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913,1920 (Fed. Cir. 1989). Furthermore, a prior art device can perform all of the functions of a claimed apparatus and yet not anticipate the claimed apparatus if the claimed apparatus and the prior art device are structurally distinguishable. *In re Robertson*, 49 USPQ2d 1949,1951 (Fed. Cir. 1999); MPEP §2114. Thus, a rejection under 35 U.S.C. §102(b) is overcome by persuasively distinguishing the subject matter and language of the claims from that which is disclosed by the cited reference. MPEP §706.02(b).

1. *With regard to the rejections of claims 1, 3, 6, 8, and 11, Walters does not disclose each, every, and all elements identically as claimed as required by 35 U.S.C. §102(b).*

Reopening prosecution, the Examiner has rejected claims 1, 3, 6, 8, and 11 under 35 U.S.C. §102(b) as being anticipated by Walters. The Applicant respectfully asserts that Walters clearly does not disclose each, every, and all elements of the rejected claims, and therefore the requirements of 35 U.S.C. §102(b) have not been met.

Of the rejected claims, claims 1 and 6 are independent. Claims 1 and 6 include the limitation of “at least one timer operable to measure the passing of a particular period of time without reference to the actual time of the day or to any specific hour or minute of the day...”. This element is inherently present in claims 3, 8, and 11 as they depend from one or the other of claims 1 and 6. In rejecting claims 1, 3, 6, 8, and 11, the Examiner asserted that “[t]he reference discloses...a timing device for timing discrete periods of time including timer 113 operable to measure periods of time without reference to actual time of day, the periods of time being the ‘SNOOZE’ time periods...” Count 2 of the third Office Action.

Walters discloses a voice recognition interface apparatus and method for interacting with a programmable timekeeping device. With regard to the prior art, according to Walters:

It is generally understood that timekeeping devices employing relatively complicated control schemes, as well as those requiring an inordinate amount of time and effort to manipulate, are often perceived to be less

desirable to the average consumer when compared to competing devices that offer a relatively simplistic and readily understandable means for interacting with the timekeeping product. Walters, col. 2, lines 6-13.

In light of this and other failings of the prior art, Walters introduces a programmable clock 20 employing a novel voice recognition interface, wherein the programmable clock 20 comprises an interface display panel 24 for effectuating verbal and visual communication between the user and the programmable clock 20. The interface display panel 24 includes microphone 32 and a speaker 34 for respectively receiving and broadcasting verbal and other audio information when interacting with the programmable clock 20; a time display 28; an alarm display 30; and various user annunciators for communicating visual prompts, commands, and interface status information to the user. The programmable clock 20 further includes an alarm switch 74 and an alarm annunciator 54; a snooze switch 76 and a snooze annunciator 60; and a time switch 78 and a time annunciator 38.

As stated in Walters, "interaction with the programmable clock is preferably effectuated by exclusive use of the novel voice recognition interface, preferably without having to operate any manually actuatable switches that may be provided to augment the operation of the voice recognition interface". Cols. 5-6, lines 65-2. It should be noted that this voice recognition feature, which is of primary and overriding importance to Walter's programmable clock, is not relevant to the patentability of the present invention.

Walters' detailed and complex procedure for programming its alarm is described, in relevant part, as follows:

...programming an alarm is preferably initiated by double tapping the alarm switch 74. The SET and ALARM annunciators 36 and 54 are preferably illuminated on the interface display panel 24 in response to double depression of the alarm switch 74. A confirmatory message such as "Programming Alarm" may be broadcast to verify the user's present intention to program or modify an alarm. At any time, a user may terminate a particular programming or querying operation preferably by verbalizing an appropriate termination command, such as "Exit" or "Terminate," or, alternatively, by double tapping the alarm switch 74. Col. 6, lines 40-10.

The available functions associated with programming the selected alarm are preferably conveyed to the user by flashing the alarm annunciators representative of the available alarm functions on the interface display panel 24, such as the SET 36, ON 56, and OFF 58 annunciators. Selecting one of the flashing alarm functions is preferably accomplished by vocalizing one of the flashing annunciators. For example, a user may vocalize the word "On" to enable or turn-on the alarm for activation at a predetermined time. After the verbal input of the word "On" is received by the voice recognition interface, the ON annunciator 56 preferably transitions from a flashing state to a solid or constant illumination state. All other annunciators, such as the SET and OFF annunciators 36 and 58, are preferably de-energized as the ON annunciator 56 transitions to the constant illumination state. Cols. 6-7, lines 63-11.

Programming the desired alarm activation time preferably involves flashing the tens-of-hours display character 45 of the alarm display 30, receiving an appropriate verbal input from the user, verifying the validity of the user's verbal input, and then illuminating at a constant illumination state the character representative of the validated verbal input in the tens-of-hours display 45. After successfully programming the tens-of-hours display character 45, the hours display character 47 is similarly programmed. A user preferably responds to the initially flashing hours display character 47 by verbally inputting an appropriate hours selection. Successful validation of the verbal input is followed by fully illuminating the character representative of the validated user input in the hours display 45. The minutes display character 49 and tens-of-minutes display character 51 are then programmed in a similar manner. After programming the tens-of-minutes character 51, the user preferably selects between the flashing A.M. and P.M. annunciators 53 and 55 by verbally inputting the word "AM" or "PM" into the microphone 32. Col. 7, lines 12-30.

It is noted that the process of programming alarm and snooze parameters, respectively initiated at steps 230 and 313, is accomplished in a manner substantially similar to that discussed above with regard to programming clock time parameters. Col. 18, lines 58-62.

Depressing the snooze control switch 76 at step 274 preferably results in temporarily suspending the alarm broadcast and initiating a snooze timer. After expiration of a predefined snooze timer duration, as tested at step 308, the alarm is rebroadcasted and program flow preferably continues at step 258. Col. 19, lines 19-24.

From this description, significant differences between Walters' programmable clock and the present invention are exceedingly clear. It is clear, for example, from the necessary step of selecting either AM or PM when setting the alarm that the alarm function is inseparably tied to the timekeeping function and that therefore the actual time must be set before the alarm can be set. This also necessarily and inconveniently requires that the alarm time be calculated relative to the alarm time, which is a disadvantage of the prior art expressly discussed in the present application. Furthermore, as stated by Walters, "[s]ingle depression of the snooze button 76, by way of further example, provides a user with a verbal indication of the preset snooze duration associated with a particular alarm". Col. 6, lines 36-39. Thus, Walters' snooze feature is inseparably associated with a previously set alarm time and cannot by itself provide an alarm and therefore, in contradiction to the Examiner's assertion, does not meet the requirement of claims 1 and 6 that timing be performed without regard to an actual time of day. It is therefore clear from a reading of Walters that, rather than allowing for timing that is independent of a particular time of day, the snooze feature requires that an actual time and an alarm time must be set, the alarm turned on, and the alarm time reached and the alarm activated. Only then can the snooze feature be selected to time a preprogrammed snooze period. Thus, the snooze feature

functions only with in conjunction with the alarm and the alarm is inseparably tied to an actual time of day.

Thus, the Examiner's characterization of Walters as disclosing "a timing device for timing discrete periods of time including timer 113 operable to measure periods of time without reference to actual time of day, the periods of time being the "SNOOZE" time..." is incorrect. As previously mentioned, to sustain a rejection under 35 U.S.C. §102, "a single reference must teach each, every, and all aspects of the claimed invention", and "[t]he identical invention must be shown in as complete detail as is contained in the...claim." *Verdegaal Bros. v. Union Oil Co. Of California*, 1051,1053 (Fed. Cir. 1987); MPEP §§706.02 and 2131; and *Richardson v. Suzuki Motor Co.*, 1913,1920 (Fed. Cir. 1989). As Walters does not disclose each, every, and all elements of claims 1 and 6, and claims 3, 8, and 11 which depend therefrom, including the claimed element of "at least one timer operable to measure the passing of a particular period of time without reference to the actual time of the day or to any specific hour or minute of the day...", the requirements of 35 U.S.C. §102(b) have not been met.

Lest the Examiner be tempted to again reopen prosecution by applying Walters under 35 U.S.C. §103, the Applicant notes the following additional fundamental differences. Walter's complex and detailed process for setting and activating an alarm is in stark contrast to the present invention's advantageously simplified process. Walters merely substitutes voice control technology for conventional push-buttons, but does not otherwise change or improve upon actual operation. Whereas the present invention requires, at a minimum, only one push or actuation to set and activate an alarm, Walters requires, at a minimum, no less than eight inputs - two "taps" of the alarm switch; selection

of an alarm function (i.e., ON, SET, OFF); programming of the tens-of-hours display character; programming of the hours display character; programming of the minutes display character; programming of the tens-of-minutes display character; and selection of AM or PM. (Note: all of the display characters must be programmed because, as discussed above, the alarm is inseparably tied to the timekeeping function). Substantially all of the disadvantages of the prior art which were expressly identified in the present application are found in Walter's programmable clock, including, for example, the need to set the alarm time with reference to the actual time and the need to separately activate the alarm once set.

2. *With regard to the rejection of claim 15, Robertson does not disclose each, every, and all elements identically as claimed as required by 35 U.S.C. §102(b).*

Reopening prosecution, the Examiner has rejected claim 15 under 35 U.S.C. §102(b) as being anticipated by Robertson. The Applicant respectfully asserts that Robertson clearly does not disclose each, every and all elements of the rejected claims, and therefore the requirements of 35 U.S.C. §102(b) have not been met.

In the second Office Action the Examiner rejected claim 15 under 35 U.S.C. §103(a) over Robertson in view of Inoue. By asserting, in Count 6, that "voice feedback signals in the timer of Robertson would be an obvious addition, as taught by Inoue", the Examiner admitted that Robertson itself does not disclose the feature of voice feedback signals. The Examiner further asserted that "[t]he length of the timing intervals has been shown to be

an obvious matter of choice”, thereby also admitting that Robertson does not disclose this feature of the present invention. Despite these admissions, in the third Office Action the Examiner rejected claim 15 under 35 U.S.C. §102(b) over Robertson alone. More specifically, the Examiner has now asserted that Robertson:

...discloses a timing device (up-down counter and inputs in Fig. 1) for timing discrete periods of time without reference to time of day, the length being settable to multiples of 30 minutes (col. 3, line 57), input device 10 for setting the period of time, measurement of the period of time being initiated automatically following setting of the timer (col. 4, lines 1-21), controller being gate 12 and the latch providing feedback signals relating to operation of the timer (i.e. when the timer is operating the feedback signals actuate the transducer to produce audible “clicks”, see col. 4, line 54), the alarm signal being the zero detect signal from the up-down counter fed to the tone oscillator (see col. 4, lines 44), and speaker referred to as “crystal audio transducer” in col. 4, line 51 for communicating the feedback and alarm signals.

Claim 15 includes the limitation of “at least one speaker operable to communicate the feedback signals and the alarm signal”. As will be appreciated by those with ordinary skill in the electrical arts, the term “audio transducer” broadly describes speakers, simple noisemakers, and substantially any other device operable to convert electrical energy into acoustic energy. A crystal audio transducer, as is disclosed in Robertson, is, however, a

simple noisemaker operable only to produce an audible “beep” or other tone. Such a simple device is ideal for Robertson’s purposes of minimizing weight, size, cost, and power consumption. These purposes are evidenced by Robertson’s statement:

In use, the device could be packaged in a small portable enclosure such as a conventional wristwatch, a locket or pendant, adapted to be worn by a child. The only control device which need protrude from the package is the programming pushbutton. The device could be adapted to be powered by an electronic wristwatch battery which is replaced no more often than it would be in such a wristwatch. Because the electronic circuitry is adapted to be made from CMOS logic elements which draw an extremely small amount of power, no power on/offswitch would be necessary. Col. 2, lines 27-36.

Thus, minimizing weight, size, cost, and power consumption is important to Robertson because its device is meant to be attached to or worn by a playing child. A speaker, however, as is required by the present invention, is a much more complex type of audio transducer having a much greater range and ability. This greater ability is necessary in the present invention in order to allow for “voicing” stored spoken messages. A speaker, however, is generally a heavier, larger, costlier, and more power consumptive device than a crystal audio transducer. As mentioned, under 35 U.S.C. §102(b) the prior art reference must disclose the identical invention as claimed. *Richardson v. Suzuki Motor Co.*, 1913,1920 (Fed. Cir. 1989). Furthermore, a prior art device can perform all of the functions of a claimed apparatus and yet not anticipate the claimed apparatus if the

claimed apparatus and the prior art device are structurally distinguishable. *In re Robertson*, 1949,1951 (Fed. Cir. 1999). Applying this to the present case, we find that Robertson does not disclose a speaker, but rather a crystal audio transducer, and therefore the invention is not shown identically as claimed and is structurally distinguishable from Robertson, and therefore the requirements of 35 U.S.C. §102(b) have not been met.

Furthermore, as discussed below in greater detail, because this difference is significant to both the present invention, which requires the greater range and ability of a speaker, and to Robertson, which requires the power efficiency, smaller size, lighter weight, and lesser expense of a simple crystal audio transducer, it could also not be obvious under 35 U.S.C. §103 to modify Robertson to include a speaker because doing so would undermine the expressed and implied purposes of Robertson.

**B. With regard to the rejections of claims 2, 4, 5, 7, 9, 10, and 16-18 under 35 U.S.C. §103, the requisite *prima facie* case of obviousness has not been established.**

Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has the benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the

Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP §2142 places upon the Examiner the initial burden of establishing a *prima facie* case which requires, among other things, that there be identified some motivation or suggestion in the prior art or in the knowledge of one with ordinary skill to modify the reference or to combine reference teachings. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

More specifically, three criteria must be satisfied in order to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) (reversing an obviousness rejection where there was no suggestion to modify a prior art mower strip to make it entirely flexible as required by applicant's claims toward a flexible landscape edging strip.); see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984). Additionally, "if the proposed modification would

render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01.

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 20 USPQ 2d 1438, 1442 (Fed. Cir. 1991). Thus, "[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

1. *With regard to the rejections of claims 2 and 7, no reasonable motivation or suggestion is identified for the proposed modification of Walters and therefore the requisite prima facie case of obviousness required by 35 U.S.C. §103 has not been established.*

Reopening prosecution, the Examiner has rejected claims 2 and 7 under 35 U.S.C. §103(a) as being unpatentable over Walters in view of Komiyama. The Applicant respectfully asserts that the combination of Walters and Komiyama does not teach or suggest all of the limitations of the rejected claims; the asserted motivation or suggestion

for the proposed modification of Walters is entirely unsupported; and the desirability of the proposed modification is not found in the prior art, and therefore the requisite *prima facie* case of obviousness has not been established.

As mentioned, the combination of prior art references must teach or suggest all of the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 1438 (Fed. Cir. 1991). Claim 2 depends from claim 1 such that the limitations of claim 1 are inherently present in claim 2, and claim 7 depends from claim 6 such that the limitations of claim 6 are inherently present in claim 7. The Examiner's rejections of claims 1 and 6 under 35 U.S.C. §102 over Walters were discussed above. The Examiner relies on Komiyama only with regard to the earphone feature of claims 2 and 7. As previously discussed, Walters' snooze feature does not satisfy the limitation of claims 1 and 6 of "at least one timer operable to measure the passing of a particular period of time without reference to the actual time of the day or to any specific hour or minute of the day...". Rather than allowing for timing that is independent of a particular time of day, the snooze feature requires that an actual time and a relative alarm time be set, the alarm turned on, the alarm time reached and the alarm activated. Only then can the snooze feature be selected to time a preprogrammed snooze period. It is clear that the snooze feature functions only in conjunction with the alarm and the alarm is inseparably tied to an actual time of day. Thus, Walters does not disclose each, every, and all elements claims 1 and 6 which are an inherent in claims 2 and 7, and the combination of Walters and Komiyama does not suffice to teach or suggest all of the claim limitations. The requisite *prima facie* case of obviousness has therefore not been established.

Even if it could be said, however, that Walters teaches or suggests all of the limitations of claims 1 and 6 which are inherently present in claims 2 and 7, the Examiner must still identify a reasonable motivation or suggestion for combining the teachings of Walters and Komiyama. Komiyama concerns an electronic wristwatch having the capability of performing a function in addition to timekeeping. In relevant part, Komiyama's wristwatch includes a radio receiver and has the capability of performing as a radio. In Count 4 of the third Office Action, dated April 9, 2003, the Examiner asserts that Komiyama "teaches provision of earphones 52 in a timekeeping device". This is, however a disingenuous characterization. More accurately, it might be said that Komiyama teaches provision of earphones in a timekeeping device having the capability of performing as a radio. The Examiner has taken Official Notice that such devices as radios and cassette players provide for earphones as an alternative or additional means for discrete audio announcements. This is again a disingenuous characterization, however, as most people would not characterize the output of radios and cassette players as "announcements". The Examiner's mischaracterization is, in fact, designed to make radios and cassette players appear more relevant to Walters even though Walters is strictly a timekeeping device and has no radio or cassette player capabilities.

Walters does not disclose earphones or the desirability of earphones. Komiyama discloses earphones but only in conjunction with the capability of performing as a radio. The Examiner's Official Notice that radios and cassette players routinely provide for earphones is irrelevant to Walters, and no Official Notice has been taken that simple timekeeping devices are routinely provided with earphones. Though the Examiner asserts that it would be obvious to one with ordinary skill in the art to provide Walters with

earphones in order to allow for discrete audio announcements, this motivation is not found in either Walters or Komiyama but is, instead, found in the Applicant's own application and subsequent arguments wherein the advantages of earphones were expounded upon. As mentioned, however, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. *In re Vaeck*, 1438, 1442 (Fed. Cir. 1991). In the present case, the Examiner's asserted motivation or suggestion is based only upon impermissible hindsight and the Applicant's own disclosure.

Thus, the combination of Walters and Komiyama does not teach or suggest all of the limitations of claims 2 and 7; the asserted motivation or suggestion for the proposed modification of Walters is entirely unsupported; and the desirability of the proposed modification is not found in the prior art, and therefore the requisite *prima facie* case of obviousness has not been established.

2. *With regard to the rejections of claims 4, 5, 9, and 10, the combination of Walters and Kutosky does not teach or suggest all of the limitations of the claims and therefore the requisite prima facie case of obviousness required by 35 U.S.C. §103 has not been established.*

Reopening prosecution, the Examiner has rejected claims 4, 5, 9, and 10 under 35 U.S.C. §103(a) as being unpatentable over Walters in view of Kutosky. The Applicant respectfully asserts that the combination of Walters and Komiyama does not teach or

suggest all of the limitations of the rejected claims, and therefore the requisite *prima facie* case of obviousness has not been established.

As mentioned, the combination of prior art references must teach or suggest all of the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 1438 (Fed. Cir. 1991). Claims 4 and 5 depend from claim 1 such that the limitations of claim 1 are inherently present in claim 4 and 5, and claims 9 and 10 depend from claim 6 such that the limitations of claim 6 are inherently present in claims 9 and 10. The Examiner's rejections of claims 1 and 6 under 35 U.S.C. §102 over Walters were discussed above. The Examiner relies on Kutosky only with regard to the length of the period specified in claims 4, 5, 9, and 10. As previously discussed, Walters' snooze feature does not satisfy the limitation of claims 1 and 6 of "at least one timer operable to measure the passing of a particular period of time without reference to the actual time of the day or to any specific hour or minute of the day...". Rather than allowing for timing that is independent of a particular time of day, the snooze feature requires that an actual time and a relative alarm time be set, the alarm turned on, the alarm time reached and the alarm activated. Only then can be the snooze feature be selected to time a preprogrammed snooze period. It is clear that the snooze feature functions only with in conjunction with the alarm and the alarm is inseparably tied to an actual time of day. Thus, the combination of Walters and Komiyama does not teach or suggest all of the limitations of claims 4, 5, 9, and 10, and therefore the requisite *prima facie* case of obviousness has not been established.

3. *With regard to the rejections of claims 16 and 17, Robertson does not teach or suggest all of the limitations of the claims and therefore the requisite prima facie case of obviousness required by 35 U.S.C. §103 has not been established.*

Reopening prosecution, the Examiner has rejected claims 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over Robertson. The Applicant respectfully asserts that Robertson does not teach or suggest all of the limitations of the rejected claims, and therefore the requisite *prima facie* case of obviousness has not been established.

In Count 6 of the second Office Action the Examiner rejected claims 16 and 17 under 35 U.S.C. §103(a) over Robertson in view of Inoue. By asserting that “voice feedback signals in the timer of Robertson would be an obvious addition, as taught by Inoue”, the Examiner admitted that Robertson itself does not disclose the feature of voice feedback signals. The Examiner further asserted that “[t]he length of the timing intervals has been shown to be an obvious matter of choice”, thereby also admitting that Robertson did not disclose this feature of the present invention. Despite these admissions, however, the Examiner has now rejected claims 16 and 17 under 35 U.S.C. §103(a) over Robertson alone.

As mentioned, the prior art reference must teach or suggest all of the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 1438 (Fed. Cir. 1991). Claims 16 and 17 depend from claim 15 such that the limitations of claim 15 are inherently present in claims 16 and 17. The Examiner’s rejection of claim 15 under 35 U.S.C. §102 over Robertson

was discussed above. Building upon this earlier rejection of claim 15, the Examiner has rejected as obvious the features of claims 16 and 17 involving specific discrete time units. Because the Applicant believes that the rejection of claim 15 under 35 U.S.C. §102 cannot be sustained because Robertson does not teach or suggest the speaker of the present invention identically as claimed in claim 15, the Applicant will extend, for purposes of thoroughness, the Examiner's 35 U.S.C. §103 rejection of claims 16 and 17 to claim 15 as well. Otherwise, claims 16 and 17 are allowable as depending from allowable independent claim 15. Thus, in order to avoid another re-opening of prosecution, the Applicant will address the as yet unmade rejection of claim 15 under 35 U.S.C. §103 wherein the Examiner might have asserted that it would be obvious to modify Robertson to replace its crystal audio transducer with the speaker of the present invention.

As previously discussed, those with ordinary skill in the electrical arts will appreciate that the term "audio transducer" broadly describes speakers, simple noisemakers, and any other device operable to convert electrical energy into acoustic energy. A crystal audio transducer, as is disclosed by Robertson, is a simple noisemaker operable only to produce an audible "beep". Such a simple device is ideal for Robertson's purposes of minimizing weight and power consumption. These purposes are evidenced by Robertson's statement:

In use, the device could be packaged in a small portable enclosure such as a conventional wristwatch, a locket or pendant, adapted to be worn by a child. The only control device which need protrude from the package is the programming pushbutton. The device could be adapted to be powered by an electronic wristwatch battery which is replaced no more often than it would

be in such a wristwatch. Because the electronic circuitry is adapted to be made from CMOS logic elements which draw an extremely small amount of power, no power on/offswitch would be necessary. Col. 2, lines 27-36.

Clearly, minimizing size and weight is important to Robertson because its device is meant to be attached to or worn by a playing child. A speaker, however, as is required by the present invention, is a much more complex type of audio transducer having a much greater range and ability. This greater ability is necessary in the present invention in order to allow for "voicing" stored spoken messages. A speaker, however, is generally heavier, larger, costlier, and more power consumptive than a crystal audio transducer. Thus, this difference is extremely significant to both the present invention, which requires the greater range and ability of a speaker, and to Robertson, which requires the power efficiency, lighter weight, smaller size, and, perhaps, lesser expense of a simple crystal audio transducer. As mentioned, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01. In this light, there can be no motivation or suggestion for modifying Robertson to include a speaker rather than a crystal audio transducer because doing so would undermine the expressed and implied purposes of Robertson.

Thus, with regard to claims 16 and 17 the requisite *prima facie* case has not been established. Furthermore, any rejection of claim 15 under 35 U.S.C. §103 would similarly fail for lack of the requisite *prima facie* case of obviousness

4     *With regard to the rejection of claim 18, no reasonable motivation or suggestion is identified for the proposed modification of Robertson and therefore the requisite prima facie case of obviousness required by 35 U.S.C. §103 has not been established.*

Reopening prosecution, the Examiner has rejected claim 18 under 35 U.S.C. §103(a) as being unpatentable over Robertson in view of Walters and Komiyama. The Applicant respectfully asserts that there can be no motivation or suggestion for the proposed modification of Robertson because the proposed modification would render Robertson unsuitable for its intended purpose, and therefore the requisite *prima facie* case of obviousness has not been established.

Claim 18 requires "at least one memory device operable to record and store a message for future playback", "at least one speaker operable to communicate the feedback signals, the alarm signal, and the message", and "an ear-phone jack operable to connect one or more earphones to the timing device and operable to communicate the feedback signals, the alarm signal, and the message, wherein the speaker is disabled while the ear-phone jack is in use".

In the second Office Action, dated July 16, 2002, the Examiner rejected claim 18 under 35 U.S.C. §103(a) over Robertson in view of Inoue and Mathurin. The Examiner admitted that Robertson does not disclose the feature of recording, storing, and playing back messages at the end of the timed period, and was therefore forced to combine the teachings of these three disparate references in an attempt to arrive at the present invention. The Applicant addressed this rejection in the original Brief on Appeal as follows:

Recall, however, that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984). Additionally, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01.

The Examiner's assertion is substantially conclusory - essentially, "it can be done, therefore it would have been obvious to do it". However, Robertson is, in fact, not a suitable device for voice announcements. As mentioned, Robertson envisions its device packaged in a small portable enclosure and using so little power that it can be powered by a wristwatch battery. The Examiner's proposed modification would require, at the very least, a speaker, a memory to store audio messages or instructions for generating audio messages, voice simulation circuitry, and a power source sufficient to supply power to these added components as they perform their complex functions. With these modifications, the device would certainly no longer fit within the space provided by a conventional wristwatch, a locket or a pendant, as Robertson envisioned, and would likely be too large, heavy, and expensive to be desirable for wear by a playing child. Thus, Robertson cannot be said to suggest the desirability of the proposed modification

because the proposed modification would render Robertson unsatisfactory for its expressed purposes.

Again, the mere fact that the proposed modification of the prior art may be possible does not equate to the proposed modification being consistent with the expressed purposes or uses of the prior art, and is therefore, by itself, an insufficient basis upon which to assert obviousness. The Examiner's simple statement that "[o]ne skilled in the art would provide this convenient feature in the Robertson device" indicates that the Examiner did not consider the impact of the proposed modification on the expressed use of Robertson device.

In reopening prosecution, the Examiner has merely substituted Walters and Komiyama for Inoue and Mathurin. This substitution does not affect the nature of Robertson and therefore the arguments set forth above and in the original Brief on Appeal continue to apply.

Again, the mere fact that the proposed modification of Robertson may be possible does not equate to the proposed modification being consistent with the expressed purposes or uses of Robertson, and is therefore, by itself, an insufficient basis upon which to assert obviousness. The Examiner has continued to ignore the impact of the proposed modification on the expressed and implied purposes of the Robertson device. The Examiner has, for example, completely failed to address the fact that Robertson envisions its device packaged in a small portable enclosure and using so little power that it can be powered by a wristwatch battery. The Examiner proposes adding a memory and a speaker

to Robertson in order to meet the elements of claim 18, but with these modifications the device would certainly no longer fit within the space provided by a conventional wristwatch, locket, or pendant as Robertson envisioned, and would likely be too large, heavy, and expensive to be desirable for wear by a playing child. Furthermore, Robertson's expressly emphasized use of low power CMOS logic elements would become irrelevant in light of the substantial increase in power requirements. Thus, Robertson cannot be said to suggest the desirability of the proposed modification as the proposed modification would render Robertson unsatisfactory for its expressed purpose. Though these considerations were emphasized in the original Brief on Appeal, the Examiner has ignored them and simply substituted Walters and Komiyama for Inoue and Mathurin.

The Examiner has also asserted that the modification of Robertson to include an earphone jack would be obvious. The Applicant has already addressed the impropriety of a similar modification of Walters asserted by the Examiner in rejecting claims 2 and 7. The Examiner has asserted that because earphones are common in radios and cassette players, their use in clocks would be obvious. The Applicant respectfully disagrees. Clocks are sufficiently different from radios and cassette players that a mere conclusory statement is by itself insufficient to establish obviousness. The only sound produced by Robertson's programmable timing device are beeps and clicks that are hardly worthy of earphones. In fact, nothing in Robertson or in any of the other cited prior art references or, the Applicant respectfully asserts, in the knowledge of those with ordinary skill in the art suggests the desirability of providing for earphones in a device that does nothing more than measure time.

Thus, with regard to claim 18, the requisite *prima facie* case of obviousness has not been established.

**C. The Examiner has not, with regard to the rejections of claims 2, 4, 5, 7, 9, 10, 13, 14, and 16-18 under 35 U.S.C. §103(a), considered the invention as a whole.**

The Examiner's rejections of claims 2, 4, 5, 7, 9, 10, 13, 14, and 16-18 under 35 U.S.C. §103(a) rely on strained and unsupported modifications of prior art references to account for all of the claimed features. The Examiner's fabrication of nonsensical motivations for making such modifications indicates that the Examiner did not consider the invention as a whole as required. Instead, the Examiner appears to have attempted to modify the prior art references without serious consideration as to whether the asserted motivations for doing so made sense in light of the very different purposes expressed in those references.

"In the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP §2141.02. Relying on strained and unsupported modifications of references in an attempt to reject each feature of the invention runs contrary to considering the invention as a whole. Even if the cited prior art references can be said to have been properly modified or validly combined and that the requisite *prima facie* case of obviousness has been made, the

question remains as to whether the invention as a whole, which is more than the mere sum of its features, has been properly considered. The mere fact that the various features of the present invention can be found over a number of disparate references or that a motivation can be fabricated for modifying or combining these references does not make the present invention as a whole obvious.

The Applicant respectfully asserts that the Examiner has treated the claimed features individually and without regard for the invention as a whole, thereby further invalidating the Examiner's 35 U.S.C. §103(a) rejections.

**D. Reopening prosecution was not proper.**

The Applicant respectfully asserts that reopening prosecution in the present case was improper, and therefore the third Office Action should be set aside and the rejections set forth therein invalidated.

MPEP §1208.01 provides that the Examiner can, with supervisory approval, reopen prosecution where a new ground of rejection is necessary. However:

There is no new ground of rejection where the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of,

the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. §103 does not constitute a new ground of rejection).

In the present case, the Examiner's self-contradictory recharacterization of Robertson to reject claim 15 under 35 U.S.C. §102 rather than, as it was previously rejected, under 35 U.S.C. §103 is merely "a change in the discussion of or rationale in support of the rejection", and is neither new nor necessary. Similarly, the Examiner's self-contradictory recharacterization of Robertson to reject claims 16 and 17 under 35 U.S.C. §103 over Robertson alone rather than, as they were previously rejected, over Robertson in view of Inoue is merely "a change in the discussion of or rationale in support of the rejection", and is neither new nor necessary. This is in fact the very scenario address by the court in *In re Kronig* when it held that "the reliance upon fewer references in affirming a rejection under 35 U.S.C. §103 does not constitute a new ground of rejection". Similarly, the Examiner's mere substitution in rejecting claim 18 under 35 U.S.C. §103 over Robertson in view of Walters and Komiyama rather than, as it was previously rejected, over Robertson in view of Inoue and Mathurin is merely "a change in the discussion of or rationale in support of the rejection", and is neither new nor necessary. In this light, it is unclear whether any discretion was exercised by the Examiner's supervisory authority in reopening prosecution.

Those rejections that rely upon prior art references not previously cited are similarly neither new nor necessary. Timme and Walters, for example, are substantially similar in

their lack of relevancy, such that removing Timme in favor of Walters adds nothing new to the rejections. If a mere change in cited references, without any showing of additional relevancy, were sufficient to reopen prosecution then appeals might never reach the Board. In the present case, for example, there may be dozens, hundreds, or even thousands of prior art patents that mention timekeeping devices but are not otherwise relevant to the patentability of the present invention.

Thus, the Applicant respectfully asserts that reopening prosecution was improper as no new and necessary grounds of rejection have been presented, and therefore the third Office Action, dated April 9, 2003, should be set aside and the rejections set forth therein invalidated.

#### **E. Conclusion**

Reopening prosecution, the Examiner has rejected claims 1, 3, 6, 8, and 11 under 35 U.S.C. §102(b) as being anticipated by Walters. The Applicant respectfully asserts that Walters clearly does not disclose each, every, and all elements of the rejected claims, and therefore the requirements of 35 U.S.C. §102(b) have not been met. More specifically, Walters' snooze feature, being inseparably tied to its alarm feature and to an actual time of day, is not identical to the claimed element of "at least one timer operable to measure the passing of a particular period of time without reference to the actual time of the day or to any specific hour or minute of the day...".

Reopening prosecution, the Examiner has rejected claim 15 under 35 U.S.C. §102(b) as being anticipated by Robertson alone, in contradiction to the Examiner's previous admission. The Applicant respectfully asserts that Robertson clearly does not

disclose each, every and all elements of the rejected claims, and therefore the requirements of 35 U.S.C. §102(b) have not been met. More specifically, Robertson's crystal audio transducer is a simple, lightweight, small, low cost, low-power noisemaker operable only to produce "beeps", and is not identical to the claimed element of "at least one speaker operable to communicate the feedback signals and the alarm signal".

Reopening prosecution, the Examiner has rejected claims 2 and 7 under 35 U.S.C. §103(a) as being unpatentable over Walters in view of Komiyama. The Applicant respectfully asserts that the combination of Walters and Komiyama does not teach or suggest all of the limitations of the rejected claims; the asserted motivation or suggestion for the proposed modification of Walters is entirely unsupported; and the desirability of the proposed modification is not found in the prior art, and therefore the requisite *prima facie* case of obviousness has not been established. More specifically, Walters' snooze feature is inseparably tied to an actual time of day and therefore does not meet the claimed element of "at least one timer operable to measure the passing of a particular period of time without reference to the actual time of the day or to any specific hour or minute of the day..." which is inherently present in claims 2 and 7. Furthermore, whereas Komiyama has the capability of performing as a radio, Walters has no such capability and is instead merely a timekeeping device for which earphones are not generally used and are not an obvious modification.

Reopening prosecution, the Examiner has rejected claims 4, 5, 9, and 10 under 35 U.S.C. §103(a) as being unpatentable over Walters in view of Kutosky. The Applicant respectfully asserts that the combination of Walters and Komiyama does not teach or suggest all of the limitations of the rejected claims, and therefore the requisite *prima facie*

case of obviousness has not been established. More specifically, Walters' snooze feature is inseparably tied to an actual time of day and therefore does not meet the claimed element of "at least one timer operable to measure the passing of a particular period of time without reference to the actual time of the day or to any specific hour or minute of the day..." which is inherently present in claims 4, 5, 9, and 10.

Reopening prosecution, the Examiner has rejected claims 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over Robertson alone, in contradiction to the Examiner's previous admission. The Applicant respectfully asserts that Robertson does not teach or suggest all of the limitations of the rejected claims, and therefore the requisite *prima facie* case of obviousness has not been established. More specifically, because Robertson emphasizes simplicity, small size, low weight, low cost, and low power consumption and produces only "beeps" it needs only a simple crystal audio transducer and therefore does not teach or suggest the claimed element of "at least one speaker operable to communicate the feedback signals and the alarm signal", with its larger size, greater weight, greater cost, and greater power consumption.

Reopening prosecution, the Examiner has rejected claim 18 under 35 U.S.C. §103(a) as being unpatentable over Robertson in view of Walters and Komiyama. The Applicant respectfully asserts that there can be no motivation or suggestion for the proposed modification of Robertson because the proposed modification would render Robertson unsuitable for its intended purpose, and therefore the requisite *prima facie* case of obviousness has not been established. More specifically, Robertson envisions its device being carried by playing children and packaged in a small portable enclosure and using so little power as to be powered by a wristwatch battery. The proposed modification involves

adding at least a memory for storing spoken messages and a speaker for voicing those messages, which would add far too much size, weight, cost, and power consumption to Robertson's device.

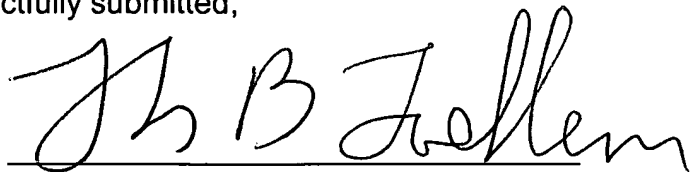
The Examiner's rejections of claims 2, 4, 5, 7, 9, 10, 13, 14, and 16-18 under 35 U.S.C. §103(a) rely on strained and unsupported modifications of prior art references to account for all of the claimed features. More specifically, the Examiner's fabrication of unsupportable motivations for making such modifications indicates that the Examiner did not consider the invention as a whole as required. Instead, the Examiner appears to have attempted to modify the prior art references without serious consideration as to whether the proposed combinations or motivations for doing so made sense in light of the very different purposes expressed in those references.

Lastly, the Applicant respectfully asserts that reopening prosecution in the present case was improper, and therefore the third Office Action should be set aside and the rejections set forth therein invalidated. More specifically, no new and necessary rejections have been made justifying reopening prosecution.

Accordingly, reversal of the Examiner's rejections is proper, and such favorable action is solicited.

Respectfully submitted,

By

A handwritten signature in black ink, appearing to read 'T B Luebbering', written over a horizontal line.

Thomas B. Luebbering, Reg. No. 37,874  
HOVEY WILLIAMS LLP  
2405 Grand Boulevard, Suite 400  
Kansas City MO 64108  
(816) 474-9050  
ATTORNEY FOR APPLICANT

## **IX. Appendix**

Claims 12-14 have been withdrawn from consideration.

Claims 1-11 and 15-18, the rejections of which are on appeal, read as follows.

1. A timing device for timing discrete periods of time, the device comprising:  
at least one timer operable to measure the passing of a particular period of time  
without reference to the actual time of the day or to any specific hour or  
minute of the day, the length of the particular period of time being adjustable  
and the adjustability being limited to multiples of a discrete number of  
minutes or hours;  
at least one input device operable to allow for adjusting the length of the particular  
period of time;  
a controller operable to provide feedback signals relating to the operation and  
operative mode of the timing device, and further operable to produce an  
alarm signal;  
at least one speaker; and  
a voice chip operable to combine with the speaker and the controller to convert the  
feedback signals to audible human speech.
2. The device of claim 1, further comprising an ear-phone jack operable to  
provide a connection point for ear-phones the connection of which causes the speaker to  
cease operating while the ear-phones are connected.
3. The device of claim 1, the input device being a button.

4. The device of claim 1, the discrete number of minutes being fifteen minutes.
5. The device of claim 1, the discrete number of hours being one hour.
6. A timing device for timing discrete periods of time, the device comprising:
  - at least one timer operable to measure the passing of a particular period of time without reference to the actual time of the day or to any specific hour or minute of the day, the length of the particular period of time being adjustable and the adjustability being limited to multiples of a discrete number of minutes or hours;
  - at least one input device operable to allow for adjusting the length of the particular period of time;
  - a controller circuit operable to provide feedback signals relating to the operation and operative mode of the timing device, and further operable to produce an alarm signal;
  - at least one speaker;
  - at least one memory device operable to record and store a message for future playback; and
  - a voice chip operable to combine with the speaker, the memory device, and the controller to convert the feedback signals and the message into audible human speech.

7. The device of claim 6, further comprising an ear-phone jack operable to provide a connection point for ear-phones the connection of which causes the speaker to cease operating while the ear-phones are connected.

8. The device of claim 6, the input device being at least one button.

9. The device of claim 6, the discrete number of minutes being fifteen minutes.

10. The device of claim 6, the discrete number of hours being one hour.

11. The device of claim 6, the device further comprising a microphone.

15. A timing device for timing discrete periods of time, the device comprising:  
at least one timer operable to measure the passing of a particular period of time  
without reference to an actual time of a day, with the length of the particular  
period of time being setable and the setability being limited to multiples of  
one or more discrete time units;  
at least one input device operable to allow for setting the length of the particular  
period of time, wherein measurement of the particular period of time is  
initiated automatically following setting of the particular period of time;  
a controller operable to provide feedback signals relating to the operation of and  
operative mode of the timing device, and further operable to produce an  
alarm signal; and  
at least one speaker operable to communicate the feedback signals and the alarm  
signal.

16. The timing device as set forth in claim 15, wherein the one or more discrete  
time units includes a discrete time unit corresponding to fifteen minutes.

17. The timing device as set forth in claim 15, wherein the one or more discrete  
time units includes a discrete time unit corresponding to one hour.

18. A timing device for timing discrete periods of time, the device comprising:

- at least one timer operable to measure the passing of a particular period of time without reference to an actual time of a day, with the length of the particular period of time being setable and the setability being limited to multiples of two or more discrete time units, wherein the two or more discrete time units include a first discrete time unit corresponding to fifteen minutes and a second discrete time unit corresponding to one hour;
- at least one input device operable to allow for setting the length of the particular period of time, wherein measurement of the particular period of time is initiated automatically following setting of the particular period of time;
- a controller operable to provide feedback signals relating to the operation of and operative mode of the timing device, and further operable to produce an alarm signal;
- at least one memory device operable to record and store a message for future playback;
- at least one speaker operable to communicate the feedback signals, the alarm signal, and the message; and
- an ear-phone jack operable to connect one or more earphones to the timing device and operable to communicate the feedback signals, the alarm signal, and the message, wherein the speaker is disabled while the ear-phone jack is in use.